REMARKS

With this amendment, claims 1-44 are pending in the application. Claims 1, 15, 26 and 41 are the only claims in independent form.

Remarks Directed Towards Claim Rejections

Remarks Directed to Rejection under 35 U.S.C. §112, Second Paragraph

Claims 1-14 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, claim 1 is cited as lacking antecedent basis for "the contact" and for "the conductor" in lines 7-8. (November 4, 2003 Office Action, page 2).

Applicant has amended claim 1 in order to clarify the claim. Applicant submits that the current claim provides proper antecedent basis for the terms "the contact" and for "the conductor." In view of these remarks and the amendments, it is respectfully requested that the rejection of claim 1 under 35 U.S.C. §112, second paragraph, be withdrawn.

Remarks Directed to Rejection under 35 U.S.C. §102(b)

Claims 1-42 were held to lack novelty under 35 U.S.C. §102(b) as being anticipated by Bonner et al. (U.S. Patent 5,968,086).

In order for the cited reference to have anticipated Applicant's invention, the reference must teach every element of the claim. (MPEP, 8th Ed., revision 1, 2131).

Regarding Claims 1-14 and 26-40

Regarding independent claims 1 and 26, a method of stimulating a region of the heart of a subject as described in these claims includes the limitation that an electrical stimulus is discharged from an intacavitarily disposed electrode of an implanted stimulus generator and

"conducted through the myocardial tissue." This element of the claims is supported by the specification which describes an inventive method wherein "[u]pon discharge of an electrical stimulus or waveform from the implanted stimulus generator, the stimulus is conducted through the myocardial tissue to the conductor where it is passively conducted to a region of the heart..." (page 3, lines 20-23). In one exemplary embodiment described in the instant specification, the passive conductor "may be placed in the pericardial space," illustrating that the electrical stimulus discharged from the intracavitarily disposed electrode is conducted through myocardial tissue, in this case the cardiac wall, to the passive conductor. (Page 13, line 2).

In contrast, Bonner et al. does not appear to teach conduction of a stimulus through myocardial tissue. Applicant has found no statement in Bonner et al. relating to conduction through myocardial tissue to a passive conductor assembly. Thus, the reference does not appear to teach every element of the claim as required in order to properly form a rejection on the basis of anticipation under 35 U.S.C. §102(b). On the basis of these arguments, it is submitted that claims 1 and 26 are not anticipated under 35 U.S.C. §102(b) by Bonner et al. Further, based on Applicant's belief as to the patentability of independent claims 1 and 26 over Bonner et al., it is submitted that claims 2-14 and 27-40 depending therefrom are likewise allowable. Therefore, it is respectfully requested that the rejection of claims 1-14 and 26-40 as anticipated by Bonner et al. be withdrawn.

Regarding Claims 15-25

Regarding independent claim 15, Applicant has amended the claim to clarify that a passive conductor assembly of the present invention as described in claim 15 is used with a physically separate implanted stimulus generator having an intracavitarily disposed stimulating lead. This is supported by the specification which describes the passive conductor as not

requiring "the running or tunneling of wires from the passive conductor assembly to the implanted stimulus generator." (Page 5, lines 8-10). Further, the orientation of a passive conductor assembly is described relative to "the separated implanted stimulus generator," again emphasizing the physical separation of these devices. (Page 10, lines 20-21).

While independent claim 15 describes a passive conductor assembly physically separate from the stimulus generator, Bonner et al. describes an "implantable electrical lead" operable in conjunction with an "implantable pacemaker/cardioverter/defibrillator to which the lead is attached..." (column 4, lines 9-10). Thus, the reference does not appear to teach every element of the claim as required in order to properly form a rejection on the basis of anticipation under 35 U.S.C. §102(b). On the basis of these arguments and the amendment, it is submitted that claim 15 is not anticipated under 35 U.S.C. §102(b) by Bonner et al. Further, based on Applicant's belief as to the patentability of independent claim 15 over Bonner et al., it is submitted that claims 16-25 depending therefrom are likewise allowable. Therefore, it is respectfully requested that the rejection of claims 15-25 as anticipated by Bonner et al. be withdrawn.

Regarding Claims 41-42

Independent claim 41 describes a method for electrically stimulating a preselected area of a heart using biologically generated current wherein different areas of the heart attain different electrical potential levels during cardiac contraction such that said preselected area of the heart is electrically stimulated using biologically generated current. The claim has been amended to clarify that an inventive method described by claim 41 is operable using a biologically generated current, for example, a current generated by contraction of the heart, the contraction creating potentials at each end of the passive conductor, resulting in conduction of the biologically

generated current. Support for this clarification is found in the specification at page 16, lines 6-13.

In contrast, Bonner et al. describes a conductor attached to an implanted pacemaker/ cardioverter/defibrillator, indicating a method of use that utilizes a stimulus generated therefrom. Bonner et al. does not appear to teach a method of electrically stimulating the heart using a biologically generated current. Thus, the reference does not appear to teach every element of the claim as required in order to properly form a rejection on the basis of anticipation under 35 U.S.C. §102(b). On the basis of these arguments and the amendment, it is submitted that claim 41 is not anticipated under 35 U.S.C. §102(b) by Bonner et al. Further, based on Applicant's belief as to the patentability of independent claim 41 over Bonner et al., it is submitted that claim 42 depending therefrom is likewise allowable. Therefore, it is respectfully requested that the rejection of claims 41-42 as anticipated by Bonner et al. be withdrawn.

Remarks Directed to Rejection under 35 U.S.C. §103(a)

Claims 43-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bonner.

In view of Applicant's belief that independent claim 41 is allowable, Applicant submits that claims 43-44 which depend from claim 41 are also patentable over Bonner under 35 U.S.C. §103(a). Applicant therefore requests withdrawal of the present rejection of claims 43-44 as obvious in view of Bonner et al.

Summary

Claims 1-44 are the pending claims in this application. Each claim is believed to be in proper form and directed to allowable and patentable subject matter. Reconsideration and allowance of the claims is requested.

Respectfully submitted,

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